

David C. Hovda et al  
Application No.: 10/656,597  
Response to Office Action of April 20, 2006  
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### REMARKS

Applicants have carefully reviewed the Application in light of the Office Action mailed April 20, 2006. At the time of the Office Action, Claims 27-44 were pending in the Application. New Claim 47 has been added. Applicants respectfully request reconsideration of the pending claims and favorable action in this case.

#### Section 102 Rejection

The Examiner rejects Claims 27, 29, 30 and 32-44 under 35 U.S.C. §102(e), as being clearly anticipated by U.S. Patent No. 6,997,925 issued to Maguire et al. (hereinafter "*Maquire*"). Applicants respectfully traverse and request reconsideration and favorable action.

Independent Claim 27 recites an electrosurgical device that includes, among other aspects, a return electrode and "at least one active electrode at the distal portion of the shaft, and having an active electrode surface area, the *active electrode further comprising an arm portion being radially spaced from the return electrode...*". (Emphasis added.)

Independent Claim 45 recites an electrosurgical system that includes, among aspects, an electrosurgical device having a return electrode and having "at least one active electrode ..., the *active electrode further comprising an arm portion being radially spaced from the return electrode ...*". (Emphasis added.)

Examiner cites to Figure 21A of *Maquire* as anticipating the limitations of Independent Claims 27 and 45, including an active electrode comprising an arm portion being radially spaced from the return electrode. Applicants note, however, that the device shown in Figure 21A (and 21B) of *Maquire* discloses alternating positive and negative ablation elements disposed circumferentially. The disposition of these elements is clearly seen in Figure 21B. As such, *Maquire* fails to disclose, teach or suggest an active electrode comprising an arm portion radially spaced from a return electrode. Instead, all of the elements of *Maquire* are disposed about a common radius and no element is provided at the center of the circle formed by the ablation elements. Additionally, the positive and negative ablation elements of *Maquire* fail to anticipate the

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active and return electrodes (which are not specifically positive or negative) of Independent Claims 27 and 45.

For at least these reasons Maquire fails to disclose, teach or suggest each and every recited limitation, and therefore cannot anticipate, Independent Claims 27 and 45. Applicants respectfully request reconsideration, withdrawal of the rejections under §102 and full allowance of Independent Claims 27 and 45 and Claims 29, 30 and 32-44 that depend therefrom.

### **Section 103 Rejection**

The Examiner rejects Claims 28 and 31 under 35 U.S.C. §103(a), as being unpatentable over Maguire. For the reasons discussed above, Applicants submit that Claims 28 and 31 depend from claims that are in condition for allowance, thereby obviating the present rejection. Applicants request reconsideration, withdrawal of the rejections and full allowance of Claims 28 and 31.

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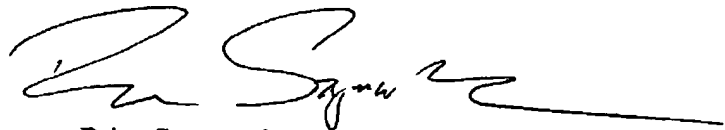
### CONCLUSION

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicants respectfully request reconsideration and allowance of the pending claims.

Although Applicants believe that no fee is due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Applicant's deposit Account No. 50-0359 for any fees that may be deemed necessary at this time to accept this Amendment.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicants invite the Examiner to contact its attorney, Brian E. Szymczak, at (512) 391-3916.

Respectfully submitted,



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